THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JAMES R. PARKER, WILLIAM J. MURPHY, CHARLES L. THOMECZEK JR., DANIEL L. KENNEDY, GARY T. NEEL and DAVID E. STORVICK

_____

Appeal No. 97-2142
Application 08/114,896[1]

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ON BRIEF

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Before CALVERT, MEISTER and CRAWFORD, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, the only claims present in the application. We reverse.

The appellants' invention pertains to a blood coagulation

[1]Application for patent filed August 31, 1993.

time measuring instrument of the type utilizing an electromagnet for creating a time-varying magnetic field. Independent claim 1 is further illustrative of the appealed subject matter and reads as follows:

> 1. An instrument comprising a detector for monitoring a change in a characteristic of a biological fluid or a control, the biological fluid or control being combined with particles which are affected by a magnetic field so that the particles become suspended relatively freely in the biological fluid or control, and an electro-magnet for creating a time-varying magnetic field which causes the particles to be reoriented as the magnetic field varies, the reorientation changing as the characteristic of the biological fluid or control changes, the electromagnet including a core comprising a first leg, an electrically conductive coil provided on the core for creating a time-varying magnetic flux in the core, a flux return provided at least partly through the core for the time-varying magnetic flux, and a drive circuit coupled to the coil for providing time-varying current flow therein.

The references relied on by the examiner are:

Hubbard et al. (Hubbard)	3,882,442	May 06, 1975
Ootsuka	4,940,958	Jul. 10, 1990
Oberhardt	5,110,727	May 05, 1992

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. § 103 as being obvious over Oberhardt in view of Ootsuka.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Oberhardt in view of Ootsuka and Hubbard.

Each of the above noted rejections is based on the exam-

iner's view that

> Oberhardt shows an instrument for determining a blood characteristic where a magnetic substance is mixed with the blood and a magnet causes the magnetic particles to orient in a manner dependent on the characteristic of the blood. No structure of the magnet is recited, but in column 4, lines 29 and 30, Oberhardt discloses that a combination of a permanent and oscillating magnetic field may be used. Therefore, any magnet producing a permanent and oscillating field would appear to [be] acceptable for the system of Oberhardt. Ootsuka teaches a magnet that produces a permanent static and oscillating magnetic field having a core having a first leg 4, a coil 6, and a return 1 and 5. From this teaching, it would have been obvious to modify Oberhardt to use the magnet structure of Ootsuka, as it is merely the substitution of one known equivalent magnet for another. [Answer, page 3.]

We will not support the examiner's position. Initially we note that the examiner appears to believe that Oberhardt does not teach any specific magnetic structure. This is not the case. Oberhardt in Fig. 5 clearly teaches an electromagnet 196 that extends perpendicularly to a permanent magnet 195.

The examiner has seized upon the fact that Oberhardt in the "SUMMARY OF THE INVENTION" makes no mention of any specific structure when generally describing the type of magnets being utilized in lines 29 and 30 of column 4. However, just because Oberhardt fails to specifically mention the structural details of the particular magnets being employed in the broad ***summary*** of the invention, does not serve as a sufficient factual basis for

establishing that "any" magnet, such as that taught by Ootsuka, may be bodily incorporated into Oberhardt's instrument as the examiner contends. Instead, it is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. ***See Uniroyal, Inc. v. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and ***Interconnect Planning Corp. v. Feil***, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Here, there is no such suggestion.

As we noted above, Oberhardt in Fig. 5 clearly depicts an electromagnet 196 which extends perpendicularly to a permanent magnet 195. From the detailed description of this magnetic structure in column 37, line 28 through column 38, line 33, it is readily apparent that Oberhardt utilizes both a ***stationary*** core and coil. The magnetic structure of Ootsuka, however, is of the solenoid-type. More specifically, Ootsuka discloses a "first leg" or core portion 4 that is ***movably*** mounted within a coil 6 and is connected to a pivoted lever or link for the purpose of moving an electrical contact carrier against the bias of a spring 14 upon the energizing of the coil. There is absolutely nothing in the combined teachings of Oberhardt and Ootsuka which would fairly suggest to one of ordinary skill in this art to bodily

incorporate the disparate solenoid-type magnetic structure of Ootsuka into the instrument of Oberhardt as the examiner proposes. This is particularly the case since Oberhardt, in order to provide for a reorientation of the magnetic particles over a period of time, cycles the power supply 199 to his stationary magnetic structure 195, 196 on and off at a desired frequency (see, e.g., column 37, lines 34-36). On the other hand, if the solenoid-type magnetic structure of Ootsuka were bodily incorporated into the instrument of Oberhardt as the examiner has proposed, Ootsuka's movable "first leg" or core portion 4 would reciprocate each time the power supply 199 was turned on and off. It is unclear, however, how such a reciprocating structure would be incorporated into the instrument of Oberhardt so as to perform the function of reorienting the magnetic particles in the manner necessary to the operation of Oberhardt's instrument.

As to the examiner's statement that it would have been obvious to substitute "one known equivalent magnet for another," we must point out that, even if it was somehow established that a solenoid-type magnetic structure was the equivalent of a stationary magnetic structure, it is well settled that equivalency does not establish obviousness. ***See In re Scott***, 323 F.2d 1016,

1019-20, 139 USPQ 297, 299-300 (CCPA 1963) and ***In re Flint***, 330 F.2d 363, 367-68, 141 USPQ 299, 302 (CCPA 1964).

With respect to the rejection of claim 5 under 35 U.S.C. § 103 based on the combined teachings of Oberhardt, Ootsuka and Hubbard, we have carefully reviewed the reference to Hubbard but find nothing therein which would overcome the deficiencies we have noted above with respect to Oberhardt and Ootsuka.

The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
JAMES M. MEISTER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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